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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,803	01/28/2000	ALLEN G. GOOD	AGZ-002	2681
7590 10/21/2003			EXAMINER	
Michael R. Ward Morrison & Foerster, LLP 425 Market Street San Francisco, CA 94105			KRUSE, DAVID H	
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/493,803	GOOD, ALLEN G.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David H Kruse	1638	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |                                                                                               |                                                                             |
|-----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

### **STATUS OF THE APPLICATION**

1. This Office action is in response to the Amendment and Remarks filed 28 July 2003.
2. Figures 17 and 18 have been cancelled as requested.
3. The Formal drawings were received on 28 July 2003. These drawings are acceptable to the Examiner.
4. Those rejections not specifically addressed in this Office action are withdrawn in view of Applicant's amendments and/or arguments.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Specification***

6. The disclosure is objected to because of the following informalities: Applicant has deleted Figures 7 and 8, consequently Applicant is now required to amend the specification on pages 15-18 as required in view of the deleted figures and formal drawings filed 28 July 2003.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. Claim 70 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At line 2, the phrase "growing a plant under 100 mM NaCl" renders the claim indefinite because it is unclear what the metes and bounds of this limitation are. It

appears, in view of the specification, that this limitation means in a growing medium comprising 100 mM NaCl. Appropriate correction is required.

At line 3, "a AlaAT gene" is indefinite because it is unclear what the metes and bounds of this limitation are. At page 22, lines 26-28, of the specification Applicant states that the target gene may not be a gene at all, hence Applicant has failed to adequately teach the metes and bounds of this limitation. It is suggested that the limitation -- a nucleic acid encoding an AlaAT enzyme -- be used, support for this language can be found on page 22, line 29 of the specification.

***Claim Rejections - 35 USC § 102***

8. Claim 70 is rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Good *et al* (U.S. Patent 6,084,153, filed 14 February 1996, published 4 July 2000).

Good *et al* disclose a plant transformed with an isolated btg-26 promoter (Applicant's SEQ ID NO: 1) operably linked to an AlaAT encoding nucleic acid (see claims 5 and 6). Good *et al* disclose a method comprising growing said transformed plant (columns 12-14). Good *et al* also disclose that the btg-26 promoter is induced under conditions of 150 mM NaCl in the growth medium (column 10, 2<sup>nd</sup> paragraph, and Figure 4D).

Good *et al* do not specifically disclose growing said transformed plant under conditions of 100 mM NaCl in the growth medium.

Alternatively, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Good *et al* to grow said

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transformed plant under conditions of 100 mM NaCl in the growth medium. Good *et al* teach that concentrations of 150 mM NaCl induce expression of coding sequences operably linked to the btg-26 promoter, and that operably linking an AlaAT encoding nucleic acid to said promoter is advantageous because plants transformed with such a construct are less susceptible to various environmental stress conditions, including high salt conditions (see claim 10, for example).

See *ex parte Novitski*, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993) The Board rejected a claim directed to a method for protecting a plant from plant pathogenic nematodes by inoculating the plant with a nematode inhibiting strain of *P. cepacia*. A U.S. patent to Dart disclosed inoculation using *P. cepacia* type Wisconsin 526 bacteria for protecting the plant from fungal disease. Dart was silent as to nematode inhibition but the Board concluded that nematode inhibition was an inherent property of the bacteria. The Board noted that applicant had stated in the specification that Wisconsin 526 possesses an 18% nematode inhibition rating.

See also *Integra LifeSciences I Ltd. V. Merck KGaA* 50 USPQ2d 1846 at 1851 (DC SCalif 1999) The Court determined that while the prior art did not disclose a required step in order to observe an inherent property of the taught method, the claimed method was still deemed anticipated. In the instant case, even though Good *et al* do not disclose growing the transformed plant in a medium comprising 100 mM NaCl, the root specific expression of the encoded AlaAT coding sequence would have been inherent, given the disclosure of Good *et al*.

Applicant argues that Good *et al* do not disclose growth under 100 mM NaCl (page 5 of the Remarks). This argument is not found to be persuasive for the reasons given above in the instant rejection.

### ***Double Patenting***

9. Claim 70 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,084,153. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '153 patent teaches growth of a transgenic plant transformed with a construct comprising a *btg-26* promoter and an *AlaAT* encoding nucleic acid and growth under osmotic stress conditions, including NaCl at a concentration of between 50 and 150 mM (column 10). While the '153 patent does not specifically teach growth of said transgenic plant under conditions of 100 mM NaCl the instant claim is deemed obvious because such a limitation lies within the range taught by the '153 patent.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. The claim is not allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (703) 306-3218. The fax telephone number for this Group is (703) 872-9306 Before Final or (703) 872-9307 After Final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read "Amy Nelson", with a stylized flourish at the end.

AMY J. NELSON, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

David H. Kruse, Ph.D.  
9 October 2003